

REMARKSI. Response to Election/Restriction

In the Office Action, restriction was made between compound and composition claims 1-10 and 17 and method of treatment claims 11-16. Applicants respectfully traverse this restriction because examination of claims 11-16 with the elected claims would not place a serious burden on the Examiner. Specifically, examination of claims 11-16 can be made without serious burden because all these claims ultimately depend from claim 1, and by definition contain all of the elements of claim 1. Accordingly, if claim 1 is patentable, then it logically follows that claims 11-16 must also be patentable. As the MPEP states, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803 (emphasis added). Accordingly, applicants respectfully request the Examiner reconsider the restriction requirement. Applicants also reserve the right to rejoin claims 11-16 upon allowance of claim 1.

The present compound claims were also restricted in the Office Action to a compound having formula I wherein:

A is a structure “i” (1,3 oxazole),

n is as claimed,

X is as N,

Y is as claimed,

Z is as claimed except further heterocyclic ring substitutions such as “NH-het”,

R<sup>1</sup> is as claimed except further heterocyclic ring substitutions as “CH+CH-het”,

R<sup>2</sup> and R<sup>3</sup> are as claimed,

R<sup>4</sup> and R<sup>5</sup> are as claimed,

R<sup>6</sup> and R<sup>7</sup> are as claimed except “C<sub>1-4</sub> heteroalkyl”, and

R<sup>8</sup> is H, F, OH, CN, C<sup>1-4</sup> alkyl, C<sup>3-6</sup> cycloalkyl and aryl.

Applicants respectfully submit that the scope of the compound claims has been unnecessarily and improperly restricted around the elected species, which the Examiner

tacitly admits is patentable as no rejection of the claims was made in the Office Action. In particular, applicants respectfully submit that substituents Z and R<sup>1</sup>-R<sup>8</sup> have been excessively restricted in the claims.

With respect to restriction of Markush claims, the MPEP states

it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

MPEP § 803.02 (emphasis added)(citations omitted). Based on this standard, unity of invention exists for the entire subject matter of all claims because the compounds not only share a common utility – antibacterial activity, they also share the common structural scaffold depicted in Formula I. This is particularly the case for compounds in which A is structure “i” and X is N.

In fact, the MPEP clearly states that

A Markush-type claim can include independent and distinct inventions. This is true [even] where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

MPEP § 803.02 (emphasis added).

Accordingly, the entire scope of the claims should be examined whether or not the Office considers the claims to contain independent and distinct inventions because unity of invention exists for the entire claim. According to the MPEP guidelines

In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.

MPEP § 803.02 (emphasis added).

In this case, the restriction requirement required election of a single species. Based on the species election, the Office Action appears to have identified “a generic concept, inclusive of the elected compound” which was selected around what the Office considered

"the scope of the independent invention encompassing the elected compound." This is in direct contradiction to the express statements set forth in the MPEP with regards to the Examination of Markush claims discussed above.

In the present case no art was cited in the Office Action that would anticipate the claims or render them obvious. In this case, where "no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended... to the extent necessary to determine patentability of the Markush-type claim." MPEP § 803.02. However, the entire claim was not examined "further to the extent necessary to determine patentability" as required by MPEP. Instead, the claims were improperly "objected to for containing non-elected subject matter." The MPEP clearly states only "[i]f the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration." MPEP § 803.02. Again, no art has been cited against the present claims that would allow restricting the subject matter of the claims to the elected species. Accordingly, applicants respectfully request the Examiner further extend the examination of the claims to determine the claims' full scope of patentability as required by the MPEP.

Applicants note that they provisionally elected the entire scope of the compound claims as required by the Examiner on the telephonic restriction of June 4, 2004, and only elected a species for examination purposes with the understanding that the claims would be examined as set forth in MPEP § 803.02.

## II. Objections

In the Office Action, claims 1-10 and 17 were "objected to for containing non-elected subject matter." As set forth above, applicants respectfully submit that the restriction of the subject matter of the claims is improper and respectfully request the Examiner reconsider and withdraw this objection.

III. Information Disclosure Statement

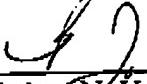
Applicants note that the Office Action did not include an initialed copy of the Form 1449 provided by applicants with the Information Disclosure Statement filed April 30, 2004. Applicants respectfully request the Examiner provide an initialed copy of Form 1449 for the Information Disclosure Statement filed April 30, 2004, indicating that the Examiner has considered the submitted references.

CONCLUSION

In view of the above remarks and amendments, applicants respectfully submit that this application is in condition for allowance and earnestly solicit notice to that effect. The Examiner is invited to contact the undersigned at the telephone number provided below if the Examiner believes such would be helpful in advancing the application to issue.

Respectfully submitted,

Date: Sept. 24 2004

  
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